

REMARKS

Claim 1 has been amended to correct a typographical error. Claims 1, 22, 33 and 42 have been amended. Claims 1-44 are pending in the application.

Specification Objections

The specification is objected to as allegedly failing to provide proper antecedent basis for the claimed subject matter. Applicant respectfully traverses this rejection.

The specification and the drawings disclose various computer products that support claims 33-41. For example, Figures 1, 2 and 3 disclose various devices that are computer products. These products may run computer software programs, such as iChat™, AIM™, etc. *See, e.g.*, Specification, page 10, ¶¶[0032]-[0033]. The hardware structures, e.g., processors, memory, etc, of the peers are described in page 10, ¶[0032] and is inherently present, as would be known to those skilled in the art upon a reading of the present disclosure, in the devices illustrated in Figure 1. Those skilled in the art having benefit of the present disclosure would readily recognize the devices that are capable of running programs such as iChat™, AIM™ indeed are an exemplary disclosures that support the claimed devices, e.g., computer program products. Therefore, based upon the exemplary embodiments disclosed in the specification, those skilled in the art would find, explicitly and/or implicitly, all of the elements of the computer program products comprising computer-readable medium, as called for by claims 33-41.

Claims Rejections Under 35 U.S.C. 112

The Examiner rejected claim 5 under 35 U.S.C. 112, second paragraph, as allegedly being indefinite. Applicant respectfully traverses this rejection.

The Examiner argues that there is no proper antecedent basis for the term “the synchronized stream.” Applicant respectfully directs the Examiner’s attention to the language of claim 4: “the stream is substantially synchronized with a portion of the active content currently active to the first application module.” As such, the phrase “the synchronized stream,” as called for in claim 4, has sufficient antecedent basis.

Therefore, claim 5 is not indefinite and is allowable for at least the reasons cited herein. Applicant respectfully requests this rejection be withdrawn.

Claims Rejections Under 35 U.S.C. 101

The Examiner rejected claims 1-21, 42-44 under 35 U.S.C. 101 as directed to non-statutory subject matter. Applicant respectfully traverses this rejection.

The Examiner rejected claim 1 for having recited a system comprising a sender peer and a recipient peer, wherein each peer comprising modules. The Examiner asserts that because the Specification recites that “in general, a peer is some type of computing device (physical or virtual),” the claim is allegedly strictly software due to the reference to the “virtual” description. However, Examiner’s own assertion indicates that the disclosure in the Specification recites that the computing device may be **physical**. Further, virtual components may also be linked with physical components. Nevertheless, the Specification clearly describes that a peer may be a “physical device.” Since it is undisputed that the “sender peer” includes an embodiment that is described to be physical, it is of proper statutory subject matter. The “virtual” embodiment does not change this fact. The Examiner has not provided authority that would indicate that in the case where it is undisputed that one embodiment of the claim term is of proper subject matter, other embodiments could possibly cause this claim to be of non-statutory subject matter. Claim 1 does not strictly reference a software structure, rather claim 1 is directed to statutory subject

matter as defined in the specification. Similar reasoning also applies to the term “recipient peer.” Further, since the recipient peer and sender peer are of proper subject matter, whether sub-elements relating to these terms (*e.g.*, first and second chat modules) are software or hardware in nature is of no moment since it is proper to claim an apparatus that has various characteristics, including hardware and software features. For at least these reasons, claim 1 is in full compliance with the requirements of 35 U.S.C. §101.

Regarding rejection of claim 42, the Examiner asserts that “recipient chat module” can be a software module and, thus, not statutory subject matter. However, this is not the case since the claim specifically calls for the recipient chat module comprising a communications module and a client module, clearly, these modules include embodiments that have physical entities and, thus, the recipient chat module is clearly not solely a software module. Therefore, claim 42 includes statutory subject matter. Accordingly, claim 42 includes statutory subject matter and is allowable for at least the reasons cited herein.

Regarding the Examiner’s rejections of claims referencing computers, claims 1-21 clearly recite a system for sharing information about an active content of a sender peer with a recipient peer. The system of claim 1 includes a sender peer that comprises an application module and a chat module. Thus, the system is a tangible object and is novel and is statutory subject matter. Regarding claims 42-44, the claims specifically call for a recipient chat module in a system for sharing active content between a plurality of peers. Again, a tangible system is referenced in these claims, and thus, contain tangible subject matter and not merely a computer program.

Furthermore, a claim is not non-statutory simply because one of the claim elements may be directed to non-statutory matter:

“Second, the Court has made clear that it is inappropriate to determine the patent-eligibility of a claim as a whole based on whether selected limitations

constitute patent-eligible subject matter. *Flook*, 437 U.S. at 594 ("Our approach to respondent's application is, however, not at all inconsistent with the view that a patent claim must be considered as a whole."); *Diehr*, 450 U.S. at 188 ("It is inappropriate to dissect the claims into old and new elements and then to ignore the presence of the old elements in the analysis."). After all, even though a fundamental principle itself is not patent-eligible, processes incorporating a fundamental principle may be patent-eligible. Thus, it is irrelevant that any individual step or limitation of such processes by itself would be unpatentable under § 101. See *In re Alappat*, 33 F.3d 1526, 1543-44 (Fed. Cir. 1994) (en banc) (citing *Diehr*, 450 U.S. at 187)." *In re Bilski*, 545 F.3d 943, 948.

Claims 1-21 indeed incorporate elements that are patent-eligible subject matter. Therefore, claims 1-21 are patent-eligible. Accordingly, Applicant respectfully submits that the original claim language meets all standards of 35 U.S.C. §112. Therefore, claims 1-21 and 42-44 are allowable for at least the reasons cited herein.

Claims Rejections Under 35 U.S.C. 102

The Examiner rejected claims 1-6, 8, 18-24, 27-35, 37-42, and 44 under 35 U.S.C. 102(e) as being anticipated by US Application 2003/0225834 (*Lee*). Applicant respectfully traverses this rejection.

Lee does not disclose or suggest all of the elements of independent claims 1, 22, 33, and 42. *Lee* does not disclose sending active content using a chat module communications path between first and second chat modules, as called for in claim 1 (as amended). The chat module communication path may refer to any communication path that is used by a chat module to communicate with another chat module. In fact, *Lee* is explicit that active content communications between chat modules would not work and proposes a solution that is entirely different from providing active content using a chat module communication path. See *Lee*, page 7, ¶¶[0065]-[0067]. *Lee* is directed to a file sharing system to share content using multiple communication paths, *i.e.*, a communication path that is separate and distinct from

communication path that links chat modules. The communications in *Lee* is between an inviter computer and an invitee computer. *Lee* discloses an “online message path” that is used to attempt to establish a separate communications path for content sharing. See *Lee*, page 7, ¶[0066]. *Lee* is explicit that the inviter computer attempts to set up a separate path for content sharing, and this path may be a “point-to-point tunneling protocol.” See *Lee*, page 7, ¶¶[0064-0066]. The separate, second port used for content sharing session is “a second communication path” that is “defined between the identified port and the invitee computer.” See *Lee*, page 7, ¶[0067]. This second communication path of *Lee* is not a chat module communication path and is clearly distinguishable from the communication path that is used for chat communications. Accordingly, *Lee* fails to disclose sending active content using a chat module communications path between first and second chat modules, as called for in claim 1.

Lee very clearly teaches using one communication path for chat communications, and a separate communication path for sending content. For example, Applicant respectfully directs the Examiner’s attention to Figure 2 and ¶¶[0065]-[0067] of *Lee*. Figure 2 of *Lee* shows a chat messaging communications path between client computers 20a and 20b and servers 10a and 10b. This communications path is used for messaging communications between these devices. See, e.g., *Lee*, Fig. 2 & ¶¶[0037]-[0038]. *Lee*, however, discloses a separate communications path for the transfer of content data. See *Lee*, Fig. 2 (30) & ¶¶[0065]-[0067] (stating “if the inviter computer determines at step 908 that the invitee has accepted the invitation, then the inviter computer attempts to establish a content sharing session on a second, or “content sharing,” communication path 30 (see FIG. 2), between the inviter computer and the invitee computer.”). *Lee* teaches that the messaging application **does not** transfer content over the messaging communication path, rather a “second,” separate connection (30) must be made to accommodate

the high-bandwidth content transfer. It should be noted that the separate connection (30) is point-to-point and does **not** pass through the web/communications servers 10a/10b. This is because the separate connection (30) is **not** utilized by the messaging module, as can be seen by a complete reading of *Lee*.

Lee is explicit in disclosing that an “online message service” with “small relatively small amount of bandwidth” is used in setting up the separate communication path for content sharing. *See Lee*, page 7, ¶[0066]. In other words, the message service is not, itself, capable of transmitting content to another client. The limited bandwidth capabilities of the message service prevent such a transfer. As taught in *Lee*, a *separate port* (and connection) is utilized to transfer content, not the port on which the online messenger service is “communicating.” *See id.* The system disclosed by *Lee* makes it impossible to perform the active content communication between chat modules called for in claim 1. Accordingly, *Lee* directs one away from the subject matter of claim 1. Because *Lee* discloses a separate path due to its limited bandwidth capabilities, *Lee* teaches a completely different way of sharing/sending information. *Lee* teaches a separate action altogether. This is in stark contrast to the chat modules called for by claim 1, which provide for sending and receiving the active content of a sender peer using a chat module communications path between first and second chat modules, as called for by the claim 1. Because *Lee* explicitly indicates that the active content communication between chat modules is impossible due to bandwidth constraints, and describes sending content on an entirely separate and distinct communication path, it necessarily follows that *Lee’s* system is entirely different from the one called for by claim 1. Thus, it is impossible that *Lee* anticipates this feature of claim 1.

Moreover, *Lee* discloses providing content to a recipient using an entirely different network. *Lee* discloses that the peer-to-peer connection path 30 goes through a network 70. *See Lee*, Fig. 2. The network 70 is separate and distinct from the communications network 60 used by the messaging applications of clients 20a/20b. Thus, not only does *Lee* fail to disclose using the chat module communication path to perform chat communication as well as send active content, *Lee* goes so far as to teach content being sent on an entirely different network. *Lee's* disclosure fails to teach using the same network for sending content, much less sending content on the same communication path as the chat communication.

The Examiner has stated that the instant messaging application in *Lee* has buttons for starting a content transfer. *See* Office Action, p.5. Even if this is true, *Lee* fails to teach a first chat module...for sending the active content for at least the reasons stated above. The Examiner has taken the position that because the messaging application can initiate a connection between two computers or relate status of the connection, the messaging application is actually sending the active content, as called for in claim 1. The Examiner's position is untenable because a complete reading of *Lee* shows otherwise. The separate peer-to-peer connection 30 disclosed in *Lee* sends the content. By virtue of the connection 30 being point-to-point, it does not use a server/connection path used by the instant messaging application. As such, the instant messaging application is **not** sending the active content, as called for in claim 1.

The Examiner also argues that *Lee* teaches an "online messenger program and media player integrated together to receive and output shared music." *See* Office Action, p.6 (citing *Lee*, ¶¶[0055]-[0057]). The cited paragraphs in *Lee*, however, do **not** teach an "online messenger program and media player integrated together to receive...shared music." As previously discussed

the sending and receiving of content is done separately from the messenger program. The Examiner has pointed to any specific teachings in ¶¶[0055]-[0057] to support his argument.

For at least these reasons, *Lee* does not teach, disclose or suggest all of the elements of claim 1.

Further, claim 22 calls for real time media content sharing through a chat network connection, which as described above, relate to subject matter that is not taught, disclosed or suggested by *Lee*. Claim 33, which calls for communications similar to claim 1 is also not taught, disclosed, or suggested by *Lee* for similar reasons. Claim 42 calls for a graphical user interface (GUI) for outputting content information from a sender peer upon receiving one or more unique identifiers based upon shared active content. *Lee* does not disclose any type of a GUI for outputting active content based upon receiving unique identifiers relating to shared active content. Accordingly, claim 42 is also allowable.

Independent claims 1, 22, 33, and 42 are allowable for at least the reasons cited herein. Further, respective dependent claims 2-21, 23-32 and 43-44 are also allowable for at least the reasons cited herein.

Claim 2 is allowable for additional features recited therein. Claim 2, depending from claim 1, calls for the second chat module further comprising a client module for requesting a stream of the active content and the first chat module further comprises a server module for sending the stream of active content in response to the request. The Examiner's rejection fails because *Lee* fails to teach at least one of the claimed features. For example, *Lee* does not teach the claimed feature of requesting a stream of the active content. The Examiner argues this feature is taught by *Lee*. See Final Office Action, p.2. In particular, the Examiner argues that a dynamic download (streaming, according to the Examiner) performed by the receiving machine teaches this

feature. *See id.*; *see also Lee*, ¶[0075]. *Lee*, however, teaches that a receiving machine may download a media file from a first machine, and that the receiving machine may begin to play the stored media file before the entire file is received. *See Lee*, ¶[0075]. This disclosure does not amount to subject matter that could anticipate the stream of active content using peer to peer communication of claim 1. In contrast to *Lee*, claim 2 calls for requesting a stream of the active content. A stream of active content, for example, would be an audio file from the first machine *as it was being listened to* by a user at the first machine. In *Lee*, the file is played at some later time after it is received, which does not anticipate the stream of active content in claim 2. Therefore *Lee* does not, and cannot, teach the claimed feature of claim 2.

Additionally, claim 2 calls for a server module for sending the stream of active content in response to the request. As discussed above with respect to the claimed feature of requesting a stream of the active content, *Lee* fails to teach or suggest such a feature. In the Advisory Action, the Examiner argues that “*Lee* clearly disclosed sending a request for the content. *See* [0078]. Clearly this also includes sending the content, since the entire purpose for the request is to receive the content.” Applicant respectfully submits that the Examiner is not viewing the claimed feature in light of the entire claim. *Lee* teaches that files may be shared between clients. *Lee* also teaches that during a file transfer, the receiving client may begin to execute the received file before the entire transfer is complete. In other words, a first client may copy a media file to a second client, and the second client may begin to play the stored portion of the file before the entire file is saved. This disclosure, however, does not describe active content streaming. Streaming does not transfer files between clients. Streaming would allow a first client to view/listen to a file broadcast by a second client without a request to copy the file as in *Lee*. *Lee* teaches file sharing, not

streaming. As such, *Lee* does not, and cannot, teach a server module for sending the stream of active content in response to the request, as called for in claim 2.

For at least the aforementioned reasons, claim 2 is allowable. Claims 3-5 are also allowable for similar reasons.

Claims Rejections Under 35 U.S.C. 103

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Lee*. Applicant respectfully traverses this rejection.

Claims 9-11, 13-17, 25-26 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Lee* in view of *Elgen*. Applicant respectfully traverses this rejection.

Claims 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Lee* in view of US Patent No. 6,383,596 (*Wiser*). Applicant respectfully traverses this rejection.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Lee* and *Elgen* as applied to claim 9, and further in view of *Wiser*. Applicant respectfully traverses this rejection.

Applicant respectfully asserts that *Lee*, *Elgen*, and/or their combination do not teach or disclose all of the elements of claim 1. In order to establish a prima facie case of obviousness, the Examiner must consider the following factors: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference(s) must teach or suggest all the claim limitations. MPEP § 2143 (2005) (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)). In making an obviousness rejection, it is necessary for the Examiner to identify the reason why a person of ordinary skill in the art would have combined the prior art references in the manner set forth in the claims. *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741

(2007). Applicant respectfully submits that the Examiner has not met this burden. Accordingly, Applicant respectfully submits that a *prima facie* case of obviousness has not been established in rejecting claims 9-11, 13-17, 25-26 and 36.

Additionally, the Office fails to produce evidence why those skilled in the art would modify *Lee* in the manner claimed. For at least these reasons, the Office did not show a case of *prima facie* case of obviousness of the claims. Under recent United States case law, specifically, *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007), regardless of the particular rationale used, a finding of unpatentability requires an Examiner to show, among other findings, a finding that one of ordinary skill in the art could have pursued known options or combined known elements *with a reasonable expectation of success*. The Office did not show that those skilled in the art would modify *Lee* with a reasonable expectation of success. In fact, Applicant respectfully submit that those skilled in the art would have an unreasonable expectation of success of active content communications between chat modules since *Lee* explicitly teaches that this would not be possible, and that a second communication path is needed for this purpose. Therefore, the Office did not show a *prima facie* case of obviousness of claims 1-6, 8, 18-24, 27-35, 37-42 and 44.

The Examiner argues in the Office Action that “evidence of a suggestion, teaching, or motivation to combine prior art references may flow from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved.” See Office Action, p.25. The Examiner uses *Elgen* to argue obviousness relating to supplements related to the active contents and/or content enhancement server of claims 9-11, 13-17, 25-26 and 36. Firstly, adding *Elgen* does not make for *Lee’s* deficit relating to the supplements related to the active contents and/or content enhancement server. *Elgen* is directed to digital online

communications. **Elgen** does not even mention chat modules except for a passing reference that lists a chat program among various applications that may reside in a computer. **Elgen** discloses a music database that may store information relating to the name of the song, the artists, etc., within the music database, but does not disclose content supplements or a content supplement database. For example, the Examiner argues that because the music database contains additional information, such as artist name, this suffices for a supplemental database. However, **Elgen** fails to disclose the supplemental database or content supplements, as called for by claims 9-11, 13-17, 25-26 and 36. As exemplified in the specification, the content supplements and supplemental database may provide other information related to the active content, such as advertisements or books about the authors of the active content. See, e.g., Specification, ¶[0056]. Further, as shown above, **Lee** does not disclose other elements of independent claims 1, 22, and 33 from which 9-11 & 13-17, 25-26 and 36 respectively depend. Still further, the Examiner failed to identify the reasons why those skilled in the art would combine **Lee** and **Elgen** in a manner provided in the claims 9-11, 13-17, 25-26 and 36. Accordingly, the Examiner failed to provide a *prima facie* case of obviousness of claims 9-11, 13-17, 25-26 and 36. Therefore, claims 9-11, 13-17, 25-26 and 36 are allowable for at least the reasons cited herein.

Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Lee** in view of U.S. Patent 6,385,596 (**Wiser**). The Examiner also rejected claim 12 under 35 U.S.C. 103(a) as being unpatentable over **Lee** in view of **Elgen**, as applied to claim 9 and further in view of **Wiser**. Applicant respectfully traverses these rejections. Adding the preview disclosure of **Wiser** to the disclosure of **Lee** and **Elgen** would not make the elements of claims 43 and 12. The data streams called for by claims 12 and 43 are not made obvious by **Wiser**, **Lee** and/or **Elgen**. As described above, the underlying independent claims (1 and 42), from which claims 12 and 43 respectively

depend are not made obvious by *Lee*, and *Wise* and/or *Elgen* do not make up for this deficit. Further, the Examiner has failed to identify the reasons why those skilled in the art would combine *Lee*, *Wiser* and *Elgen* in a manner provided in the claims 12 and 43. *See KSR*, at 1741. Accordingly, the Examiner failed to provide a *prima facie* case of obviousness of claims 12 and 43. Therefore, claims 12 and 43 are allowable for at least the reasons cited herein.

For at least the aforementioned reasons, claims 1-44 are allowable.

Reconsideration of the present application is respectfully requested.

Applicant respectfully asserts that in light of the arguments provided throughout the prosecution of the present application, all claims of the present application are now allowable and, therefore, request that a Notice of Allowance be issued. Reconsideration of the present application is respectfully requested.

If for any reason the Examiner finds the application other than in condition for allowance, **the Examiner is respectfully requested to call the undersigned attorney** at the Houston, Texas telephone number (713) 934-4064 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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